16PM

Docket No.: PF-0502-1 DIV 1634

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Box Non-Fee Amendment,** Commissioner for Patents, Washington, D.C. 20231 on 3/7/03.

By: Margaret M. Hasson Printed: Margaret M. Hasson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lal et al.

Title: HUMAN UBIQUITIN-CONJUGATING ENZYME HOMOLOGS

Serial No.: 09/930,026 Filing Date: August 14, 2001

Examiner: Myers, C. Group Art Unit: 1634

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL FEE SHEET

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return Receipt Postcard;
2. Response to Restriction Requirement (3 pp.);
3. Preliminary Amendment (8 pp); and
4. Certificate Under 37 C.F.R. §3.73(b), Revocation of Power of Attorney and Appointment of New Attorneys (2 pp.).

The fee has been calculated as shown below.

Claims	Claims After Amendment	-	Claims Previously Paid For	=	Present Extra	Other Than Small Entity Rate	Fee		Additional Fee(s)
Total	23	-	23		0	x$18.00		$	0
Indept.	2	-	3		0	x$84.00		$	0
First Presentation of Multiple Dependent Claims						+280.00		$	0
							Total Fee:	$	0

X No additional Fee is required.

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. 09-0108. **A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: March 7, 2003 David G. Streeter

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Serial No.:	09/930,026	Filing Date:	August 14, 2001
Examiner:	Myers, C.	Group Art Unit:	1634

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated February 13, 2003, setting a one (1) month term for response.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1, 2, 16 and 17) drawn to ubiquitin-conjugating homologs.

Group II (claims 9 and 11) drawn to nucleic acids encoding ubiquitin-conjugating homologs and methods of detecting said nucleic acids.

Group III (claim 10) drawn to antibodies.

Group IV (claims 13-15) drawn to methods of detecting nucleic acids.

Group V (claim 18) drawn to a method of treatment with a protein.

Group VI (claim 19) drawn to methods of screening for an antagonist.

Group VII (claim 20) drawn to an agonist.

Group VIII (claim 21) drawn to methods of treatment with an agonist.

Group IX (claim 22) drawn to methods of screening for an antagonist.

Group X (claim 23) drawn to an antagonist.

Group XI (claim 24) drawn to methods of treatment with an antagonist.

Group XII (claim 25) drawn to methods to identify a compound that binds a protein.

Group XIII (claim 26) drawn to a method of screening for compounds that modulate the activity of a ubiquitin protein.

Group XIV (claim 27) drawn to methods of screening compounds that increase the expression of a ubiquitin nucleic acid.

Group XV (claim 28) drawn to methods of assaying for toxicity of a compound.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1, 2, 16 and 17 . Applicants object to the Examiner's excessive and unwarranted restriction of method claims from their composition of matter claims and from one another. The Examiner is reminded that proper restriction requires the following two conditions be met according to MPEP 803:

Restriction-When Proper:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

> (A) The inventions must be independent (see MPEP Section 802.01 Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and
>
> (B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02 Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02). (Emphasis added.)

The Examiner has provided no evidence that the methods of use of the polypeptides of the invention as recited in Groups IV, VI, IX, and XII-XV that depend from and are therefore of the same scope as the composition of matter of claims of Group I would pose an undue burden to be examined together. In addition, the Examiner has improperly restricted methods claims of the same type from one another. This is particularly evident from the fact that several of the Groups are classified in the same class and subclass and could clearly be examined together without undue burden. See, for example, Groups IV, XIV, and XV (class 435, subclass 6); and Groups VI and XIII (class 435, subclass 4).

Applicants further submit that the Examiner has overlooked claims 45 and 46 that are also drawn to the polypeptides of SEQ ID NO:1 and SEQ ID NO:2, respectively, and should therefore also be examined with the claims of Group I.

Accordingly, applicants request reconsideration of the Restriction Requirement and examination of claims 1, 2, 9, 16, 17, 19, 22, 25, 26, 45 and 46. In the event the Examiner maintains the Restriction Requirement, Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications. Applicants further submit that upon allowance of the composition of matter of claim 1, that claims 9, 19, 22, 25, and 26 are subject to rejoinder as methods of making and/or using the product of claim 1 in accordance with *In re Ochiai and Brouwer* and the MPEP § 1801.04.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: March 7, 2003

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